

Remarks

Claims 14 through 16 are pending in this application. Claims 7, 8, 10, 12, and 13 were previously cancelled by preliminary amendment. Claims 1 through 6, 9, and 11 were previously cancelled in the Reply Under 37 C.F.R. 1.111 & Amendment Under 37 C.F.R. 1.121. The pending claims stand rejected under 35 U.S.C. §112, first paragraph and 35 U.S.C. §103(a), while also standing provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

This paper contains amendments under 37 C.F.R. §1.116. The present claims are limited to the exemplified compounds. Applicants affirmatively retain the right to pursue the subject matter of the cancelled claims in a later application, if desired.

Rejection Withdrawn

Applicants note the Office's withdrawal of the rejection 35 U.S.C. §112, second paragraph, for Claims 1 through 9 and 11 in view of Applicants' amendment filed on September 11, 2007.

Rejection of Claim 16 under 35 U.S.C. §112, First Paragraph

Claims 16 is rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. While Applicants do not acquiesce to the merits of this rejection, Claim 16 has been cancelled. As such, Applicants assert that the rejection is obviated and respectfully request withdrawal of this rejection.

Rejection of Claims 14 through 16 under 35 U.S.C. §103(a)

Claims 14 through 16 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sawyer et al. (WO 2002/094833). Under 35 U.S.C. 103(c)(1), patentability is not precluded "where the subject matter [developed by another person] and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Both Sawyer et al. and the present application were, at the time the invention was made, subject to an obligation of assignment to Eli Lilly and Company. Applicants further note that the priority date for the present application is November 27, 2002 while the publication date for Sawyer et al. is November 28, 2002. Thus, Sawyer et al.

is disqualified prior art against the claimed invention, making the rejection under 35 U.S.C. §103(a) improper. Applicants respectfully request withdrawal of this rejection.

Rejection of Claims 14 through 16 under the Judicially Created Doctrine of Obviousness-

Type Double Patenting

Claims 14 through 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 1 through 4 of Beight et al. (US 2006/0040983), Claims 4 through 7 of Sawyer et al. (US 2006/0079680), and Claims 1 through 7 of Sawyer et al. (US 7,087,626). While Applicants do not acquiesce to the merits of this rejection, Claims 15 and 16 have been cancelled. Applicants, therefore, respectfully disagree with this rejection for Claim 14.

The analytical methodology used in obviousness-type double patenting parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985). Also see M.P.E.P. §804(II)(B)(1) (Aug. 2006). Furthermore, due to this parallel, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) are employed when making an obvious-type double patenting analysis. Those factual inquiries include: A) determine the scope and content of a patent claim relative to a claim in the application at issue; B) determine the differences between the scope and content of the patent claim as determined in A) and the claim in the application at issue; C) determine the level of ordinary skill in the pertinent art; and D) evaluate any objective indicia of nonobviousness. Note that when conducting an obviousness-type double patenting analysis, the fundamental difference between obviousness under § 103 and obviousness-type double patenting is that § 103 inquires into obviousness in view of the entire disclosure of the prior art reference, while the issue presented by double patenting is obviousness in view of the reference patent *claims*. See *Gen. Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1278 (Fed. Cir. 1992). Therefore, only the claims from the cited patents are compared to the claims of the application.

A finding of obviousness under 35 U.S.C. § 103(a) requires that the prior art suggest the claimed invention, as a whole, to one of ordinary skill in the art. Thus, the obviousness inquiry of 35 U.S.C. § 103(a) requires a factual comparison of the claimed subject matter to the relevant art. To render a claim obvious, the prior art must be such as to lead one of ordinary skill in the art to arrive at the claimed invention with a reasonable expectation of success.

For each of the three references cited (Claims 1 through 4 of Beight et al. (US 2006/0040983), Claims 4 through 7 of Sawyer et al. (US 2006/0079680), and Claims 1 through 7 of Sawyer et al. (US 7,087,626)), the Office states that each reference “claimed analog compounds... as the instant claims” and that “the difference between the instant claims... and the reference claims... is that the reference claims has R₂ substituent being quinoline instead of [isoquinoline] in the instant application.” The Office proceeds to assert that quinoline and isoquinoline are positional isomers, which the skilled artisan can substitute “one instead of the other.” Applicants will reply to these rejections separately below.

Rejection Over Beight et al. (US 2006/0040983; the ‘983 application)

Applicants respectfully submit that the claims in the ‘983 application do not teach the presently claimed compounds in Claim 14. The ‘983 application contains a claim to a species compound, and the pharmaceutically acceptable salts thereof, which is 2-(6-methyl-pyridin-2-yl)-3-[6-amido-quinolin-4-yl]-5,6-dihydro-4H-pyrrolo[1,2-b]pyrazole. This specific compound has at least two structural differences between the presently claimed compounds and that claimed compound. For example, the isoquinoline compounds in the present claims, at minimum, do not possess the amine substituted carbonyl present on the quinoline moiety as claimed in the ‘983 application. The changes from these multiple structural requirements in the ‘983 application’s claims to arrive at the presently claimed compounds is neither taught nor suggested by the claims or the relevant portions of the disclosure that provide support to those claims. These changes, also, are greater than a single positional isomer change. This example illustrates that this application’s claims are not obvious in view of the ‘983 application. As such, no obviousness-type double patenting can exist over the ‘983 application.

Rejection Over Sawyer et al. (US 2006/0079680; the ‘680 application)

Applicants respectfully submit that the claims in the ‘680 application do not teach the presently claimed compounds in Claim 14. The ‘680 application contains claims to compounds containing both quinoline and 5,6,7,8-tetrahydro-4H-pyrazolo[1,5-a]azepine. There are at least two structural differences between the presently claimed compounds and the compounds claimed in the ‘680 application. At minimum, no compounds in the present claims possess quinoline, nevertheless both quinoline and 5,6,7,8-tetrahydro-4H-pyrazolo[1,5-a]azepine. These structural differences are neither taught nor suggested by the claims or the relevant portion of the disclosure supporting those claims in the ‘680 application’s claims and are more than a single positional

isomer change. The claims of this application are not obvious in view of the claims in the '680 application. Thus, no obviousness-type double patenting can exist over the '680 application.

Rejection Over Sawyer et al. (US 7,087,626; the '626 patent)

Applicants respectfully submit that the claims in the '626 patent do not teach the presently claimed compounds in Claim 14. The '626 patent contains generic claims to compounds containing, at times, for example, a quinoline substituent at R₂. Applicants note that no species compounds are claimed in the '626 patent. These claimed genera in the '626 patent encompass a large number of compounds, which neither point to the particular combinations of substituents needed to arrive at the specific compounds presently claimed nor supply any teachings on the variations necessary to render the present compounds obvious to the skilled artisan. The presence of, for example, isoquinoline containing compounds in the present claims and quinoline containing compounds in the '626 patent's claims does not provide sufficient information to ascertain all of the additional structural features necessary to arrive at the present compounds. Furthermore, the portions of the disclosure which provide support to the patent claims do not supply teachings that would lead the skilled artisan to the presently claimed compounds. As such, this application's claims are not obvious over the claims in the '626 patent. Therefore, no obviousness-type double patenting can exist in view of the '626 patent.

In view of the discussion above, the claims in Beight et al. (US 2006/0040983), Sawyer et al. (US 2006/0079680), and Sawyer et al. (US 7,087,626) do not render Claim 14 obvious, making Claim 14 patentably distinct from the cited references' claims. Applicants respectfully request withdrawal of this rejection.

Conclusion

Applicants assert that the above-stated remarks overcome the Office's rejections for this application. Applicants courteously solicit reconsideration of these rejections and passage of this case to issuance.

Respectfully submitted,

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